UNITED STATES PATENT AND TRADEMARK OFFICE

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10/652,315	09/02/2003	Hiromitsu Takayama	402768	1740

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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/652,315	TAKAYAMA, HIROMITSU
	Examiner	**Art Unit**
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 January 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-4 and 18-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-4, 18-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claims 2-4 and 18-20 have been examined.

Response to Amendment

The Amendment filed on 1/30/08 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   **Claims 18-20, 2-4 are rejected under 35 U.S.C. 102(e) as being anticipated by do Rosario Botelho et al. (US 2002/0069105 A1) (hereinafter "Botelho et al.").**

2.   Claims 18-20: Botelho et al. teaches of a system and method where "users (e.g. consumers) decide what type of advertisements (or other content) they want to view." (Abstract). In particular, Botelho et al. teaches of a system and method comprising:

  –   an advertising server that transmits advertisement information including various

      advertisement categories (Abstract; [0009]; Fig. 4; [0036], [0039]-[0040])

  –   a client terminal that receives the advertisement categories ([0039]-[0040])

- a user selects advertisement categories on the terminal and the terminal transmits it to the server ([0010], [0039]-[0041])

- the server receives the selected category and determines targeted advertisements based on the selection ([0010], [0012], [0035]-[0036])

- the server then transmits the advertisement to the client terminal where it is displayed ([0012]; [0042]-[0043]; Fig. 11).

Botelho further discloses an advertising server with storage for storing advertising information, means for generating relevant advertisements, and means for communicating with client terminal ([0028]-[0030]; [0033]-[0038]); a client terminal with display for displaying advertisement and category information ([0031]); and a network for communicating between the client terminal and advertisement server ([0034]).

Botelho further discloses a display ([0031]); means for displaying advertising information on the display ([0031]); means for storing advertisement information ([0030]-[0031]; [0040]); means for selecting a category ([0031]); and means for communicating with the server ([0034]).

Additionally, Botelho discloses that the webpage content and advertising content come from independent servers and independent sources ([9-11]).

Botelho further discloses that the webpage content and advertising come from independent servers and independent sources:

"[0009] In one embodiment, when a user accesses a website on the Internet, the web page displayed will have one or more advertisements according to the present invention. Typically (but not required), the web page is a web page by

a web publisher other than an entity associated with the servers of the present

invention or the products of the advertisement."

Also, notice that Botelho discloses that the advertising section can be navigated and

changed while the content section remains the same :

"[10]. . .Although an original advertisement is replaced with a new advertisement, the

content of the web page is not changed. The advertisements are typically stored on a server,

which can include a central advertisement database and/or a cache located at or

remote from the database.

[9]. . .In one alternative, the selection of the category and the serving of the

advertisement are performed in real time. That is, while a user is viewing a publisher's page,

the user can select the category and receive the targeted advertisement."

Hence, the ads can change while the webpage content remains the same (preceding

citation from [10]). Hence, they are from independent sources. Also, the there is an ad server

and a central advertisement database and an independent "web page by a web publisher other

than an entity associated with the servers of the. . .advertisement" ([9]).

Additionally, Botelho et al. teaches of using various categories and properties in order to

determine the type of advertisements that are displayed. ([0040]). In particular, Botelho et al.

teaches of selecting advertisements based on the users selection, advertisers selection, and server

properties, or a combination thereof. ([0040]). The server properties include user information

such as geographic origin and language. ([0040]).

Also, Botelho et al. teaches of using various categories and properties to determine the

type of advertisement that are displayed. ([0040]). Botelho et al. further teaches of using

transient properties, i.e. properties corresponding to the way the advertisement is displayed, in

addition to other properties to determine the type of advertisement displayed. ([0039]-[0040])

Also, Botelho et al. teaches of updating the entire screen or of updating a specific

advertisement. ([0042]-[0045]).

3.   Regarding claim 2, Botelho et al. teaches that the user selects the advertisements using an

AdRemote, the AdRemote having buttons for the user to select. (Fig. 4; Fig. 6; [0041], [0046]).

4.   Regarding claims 3 and 4, Botelho et al. teaches that the category information selected by

the user "can be stored in one or more cookies on either the client side or the server side."

([0040]). Botelho further discloses tracking user and screen related information ([6, 9, 38, 41]).

Response to Arguments

Applicant's arguments with respect to claims the claims have been considered but are not

found persuasive.

On page 8 of the Applicant's Remarks dated 1/30/08, Applicant states regarding

Applicant's invention, "Thus, in the invention, different information linked to different

information resources can be simultaneously displayed since the advertising area and web page

area are provided independently in the client terminal. . .In addition, in the invention, a user of a

client terminal can freely display web page information received from different information

resources. . ."

On page 9, Applicant states that the prior art does not disclose, "This combined

information is transferred to the client terminal which displays, in an integral, not independent,

fashion the combined information. Therefore, unlike the invention, it is impossible in Botetho to

display the advertisement information with unrelated web page resources simultaneously on the

client terminal. As a further example of the linkage in Botetho, the advertisement information

displayed on the advertising area of the client terminal in Botelho disappears when other

information displayed by the client terminal is changed. This linkage is clearly contrary to the

invention as defined by the claims now pending."

Examiner notes that Applicant has not stated where support can be found for these new

features. Examiner notes that stating where these new features can be found in the Specification

assists clarifying the invention and demonstrating 35 USC 112 support.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims

that are being rejected with the prior art. Also, although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are

given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664

(Fed. Cir. 2000).

Hence, it is the Applicant's claims as stated that are interpreted with a broadest

reasonable construction.

And, Examiner notes that Botelho does disclose that the webpage content and advertising

content come from independent servers and independent sources ([9-11]). Botelho further

discloses that the webpage content and advertising come from independent servers and

independent sources:

"[0009] In one embodiment, when a user accesses a website on the Internet, the

web page displayed will have one or more advertisements according to the

present invention. Typically (but not required), the web page is a web page by

a web publisher other than an entity associated with the servers of the present

invention or the products of the advertisement."

Also, notice that Botelho discloses that the advertising section can be navigated and

changed while the content section remains the same :

"[10]. . .Although an original advertisement is replaced with a new advertisement, the

content of the web page is not changed. The advertisements are typically stored on a server,

which can include a central advertisement database and/or a cache located at or

remote from the database.

[9]. . .In one alternative, the selection of the category and the serving of the

advertisement are performed in real time. That is, while a user is viewing a publisher's page,

the user can select the category and receive the targeted advertisement."

Hence, the ads can change while the webpage content remains the same (preceding

citation from [10]). Hence, they are from independent sources. Also, there is an ad server and a

central advertisement database and an independent "web page by a web publisher other than an

entity associated with the servers of the. . .advertisement" ([9]). Also, notice that the ads can be

navigated or interacted with extensively ([11]) without changing the webpage content.

Hence, Botelho anticipates the features of the Applicant's claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
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2/26/2008